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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/527,796 | 03/15/2005 | Minoru Azakami | 123738 | 7519 |
| 25944 7590 03/24/2009 OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850 | | | | |
| EXAMINER | | | | |
| NORDMEYER, PATRICIA L | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1794 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 03/24/2009 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/527,796

Applicant(s)

AZAKAMI ET AL.

Examiner

Patricia L. Nordmeyer

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-11 is/are pending in the application.
- 4a) Of the above claim(s) 9-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 2, 2009 has been entered.

Withdrawn Rejections

2. Any rejections and or objections, made in the previous Office Action, and not repeated below, are hereby withdrawn due to Applicant's amendments in the response dated March 2, 2009.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 – 5, 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chatwin et al. (USPN 5,310,222) in view of DE 4314579 A1.

Chatwin et al. disclose a counterfeiting prevention label (Column 2, line 1) comprising: a base sheet (Column 6, lines 22 – 23); and a volume hologram layer covering a part of a front surface of the base sheet (Column 7, lines 1 – 4); wherein the volume hologram layer extends between a first end of the base sheet and a second end of the base sheet opposite the first end (Figure 1, #3), the end surface of one end of the volume hologram layer is flush with the end surface of the first end of the base sheet (Figure 1, #3), and the end surface of the other end of the volume hologram layer is flush with the end surface of the second end of the base sheet (Figure 1, #3), wherein a self-adhesive layer is formed on a back surface of the base sheet, and the adhesive layer is covered with a release sheet that is larger than the base sheet (Column 4, lines 46 – 56) as in claim 1. With regard to claim 2, the base sheet has a quadrilateral shape (Column 4, lines 46 – 56), and the volume hologram layer extends between a first side of the base sheet and a second side of the same opposite the first side (Figure 1, #3). As in claim 3, the volume hologram layer is bonded to the front surface of the base sheet with a heat-sensitive adhesive layer or a pressure-sensitive adhesive layer (Column 6, lines 23 – 30). Regarding claim 4, the surface of the volume hologram layer not facing the base sheet is coated with a protective layer (Figure 1, #6). As in claim 7, the release sheet is larger than the base sheet, the base sheet, the volume hologram layer and the self-adhesive layer form a laminated structure, a plurality of laminated structures are arranged on the release sheet, and the laminated structures have substantially the same desired shape in a plane and are spaced apart from each other (Column 4, lines 46 – 56). Regarding claim 8, characters are printed on the volume hologram layer and/or a part, not coated with the volume hologram layer, of the front surface of the base sheet (Column 4, lines 1 – 6). However, Chatwin et al. fail to disclose the volume hologram having a shape of a

ribbon, the volume hologram layer does not cover the entire surface of the base sheet and a part, coated with the volume hologram layer, of the surface of the base sheet is depressed relative to a part, not coated with the volume hologram, of the surface of the base sheet to form a depression.

DE 4314579 A1 teaches an adhesive label (Derwent Abstract) with a volume hologram having a shape of a ribbon (Derwent Abstract; Figure, #1), the volume hologram layer does not cover the entire surface of the base sheet (Derwent Abstract; Figure, #1) and the end surface of the other end of the volume hologram layer is flush with the end surface of the second end of the base sheet (Derwent Abstract; Figure, #1) for the purpose of forming a security label that has a printable surface (Derwent Abstract).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the ribbon hologram that does not cover the entire surface of the base sheet in Chatwin et al. in order to form a security label that has a printable surface as taught by DE 4314579 A1.

As to claim 1, the recitation that the volume hologram is "formed by a transfer process" is a process recitation in a product. Product claims including process recitations are not limited by the manipulation of the recited steps, only the structure implied by the steps. See MPEP 2113. In the present instance, the process steps imply that the volume hologram is part of the label structure. The reference discloses such a product (Column 2, line 1).

With regard to the limitation the surface of the base sheet is depressed relative to a part, it is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape provides significant unforeseen improvements to the invention. In the instant case, the application does not indicate any new, significant attributes of the invention due to its shape which would have been unforeseen to one of ordinary skill in the art. MPEP 2144.04 Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to change the shape of the base layer. One skilled in the art would have been motivated to do so in order to change the appearance of the object to which the label is adhered.

Response to Arguments

5. Applicant's arguments with respect to claims 1 – 5, 7 and 8 have been considered but are moot in view of the new ground(s) of rejection.

With regard to Applicant's argument that the prior art fails to teach the volume hologram layer does not cover the entire surface of the base sheet, please see the new rejection above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571)272-1496. The examiner can normally be reached on Mon.-Fri. from 10:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Patricia L. Nordmeyer
Primary Examiner
Art Unit 1794

/Patricia L. Nordmeyer/
Primary Examiner, Art Unit 1794